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FEB 18 2004

OFFICE OF PETITIONS

In re Application of
Lee, et al.
Application No. 10/651,200
Filed: August 29, 2003
Attorney Docket No. 29250-000938/US
For: METHOD AND ARRANGEMENT FOR
DETECTING A RANDOM ACCESS CHANNEL
PREAMBLE USING MULTIPLE ANTENNA
RECEPTION IN A COMMUNICATION SYSTEM

ON PETITION

2631

This is a decision on the petition under 37 CFR 1.53(e) requesting that the application be accorded a filing date of August 29, 2003 with Figures 2-4 added by way of preliminary amendment. In the alternative, petitioners request consideration under 37 CFR 1.182 to accord the application a filing date as of the date Figures 2-4 were filed in the Office. Both petitions were filed in the same paper on December 9, 2003.

The petition under 37 CFR 1.53(e) is **DISMISSED**.

The petition under 37 CFR 1.182 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

The application was filed on August 29, 2003. However, on November 21, 2003, The Office of Initial Patent Examination mailed a "Notice to File Missing Part(s) of Nonprovisional Application" (Notice) stating, *inter alia*, that the application had been accorded a filing date of August 29, 2003, and advising applicants that Figures 2-4 referenced in the specification appeared to have been omitted.

In response, the present petitions were filed.¹ Petitioners argue that Figures 2-4 are not necessary for the understanding of the invention and that Figures 2-4 do not constitute new matter. Therefore, petitioners request that the application maintain a filing date of August 29, 2003 with Figures 2-4 added to the original disclosure. In the event that a filing date of August 29, 2003 is not accorded to the application, petitioners request that a filing date of December 9, 2003 be accorded because December 9, 2003 is the date that Figures 2-4 were filed in the Office, but reserve the right to file a reconsideration petition under 37 CFR 1.53(e).

The mailing of the Notice permitted applicants to either: (1) promptly establish prior receipt in the PTO of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items in a nonprovisional application and accept the date of such

¹ Pursuant to petitioners' authorization, deposit account no. 50-1188 has charged two \$130.00 petition fees.

submission as the application filing date. An applicant asserting that the missing items were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the Notice (37 CFR 1.181(f)).

In this case, petitioners do not assert that the missing figures were actually deposited in the PTO on August 29, 2003. Petitioners assert that Figures 2-4 are fully described in the specification filed on August 29, 2003 and do not contain new matter. Whether the later filed drawings contain new matter is not the issue. Either the drawings were present in the Office on the filing date of the application or they were not. If they were not present on the filing date, they cannot be considered a part of the original disclosure of the application.

Applicants do not allege in the petition that Figures 2-4 were present in the Office on August 29, 2003, and a review of the file confirms that Figures 2-4 were not present on August 29, 2003. Therefore, the application cannot be accorded a August 29, 2003 filing date with the drawings of Figures 2-4 as a part of the original disclosure. The issue of new matter is one appropriately addressed during prosecution of the application after the filing date of the application has been determined.

Of course, applicants may submit the drawings of Figures 2-4 as an amendment to the drawings in which case the examiner will determine whether the additional sheet of drawing contains new matter (see MPEP 608.02(h)). The Office will not *sua sponte* add Figures 2-4 without the filing of a formal preliminary amendment adding the figures and the examiner's review for new matter.

The petition under 37 CFR 1.53(e) is **DISMISSED**. The filing date of the application (without Figures 2-4) is still August 29, 2003.

In the alternative, petitioners request a later filing date for the application. The earliest date that can be accorded to this application with Figures 2-4 as part of the disclosure is December 9, 2003, which is the date that Figures 2-4 were received in the Office.

This later filing date petition is grantable, but petitioners have reserved the right to reinstate the petition under 37 CFR 1.53(e). Flip flopping on the filing date may necessitate extra searches through prior art and additional Office actions. If the later filing date were accorded and then petitioners filed papers to change the filing date back to the original filing date, the Office could construe it as petitioners' failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application. Under 37 CFR 1.704(a), petitioners could lose patent term. Therefore, the petition under 37 CFR 1.182 is **DISMISSED**.

Petitioners must clarify their wishes. **EITHER** submit Figures 2-4 as a preliminary amendment to the drawings for the examiner to review for new matter **OR** submit a reconsideration petition under 37 CFR 1.182 clearly requesting the later filing date without reservation. As stated, the current filing date of the application without Figures 2-4 is August 29, 2003.

Further correspondence with respect to this matter should be addressed as follows:

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The application is being returned to Initial Patent Examination Division for further processing with a filing date of **August 29, 2003**. Figures 2-4 will not be considered as part of the original disclosure.

Thereafter, the application will be forwarded to Technology Center 2600 for examination in due course.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6712.



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